

REMARKS

Attorney for Applicants has carefully reviewed the outstanding final Office Action on the above-identified application. Applicants have amended the application, as set forth herein, and respectfully submit that the application, as amended, is in condition for allowance. A Request for Continued Examination (RCE) is being filed on even date herewith.

Applicants have amended independent Claim 29 to recite the features of the present invention of **"calculating a total risk score for each loan based on scored variances; assigning a risk category to the loan based on the total risk score; and displaying the total risk score and the risk category** for each loan to a user of the system." Applicants have also amended dependent Claim 30 to provide consistency with amended independent Claim 29, cancelled dependent Claim 37, and amended dependent Claims 38-40 to depend from amended dependent Claim 30 and to further define the present invention. Specifically, dependent Claims 38-40 were amended to recite that the present invention **displays "pass," "high risk," and "investigate" status indicators to a user of the system**, based upon a sum of scores.

Applicants respectfully traverse the rejection of Claims 29-36 raised in the Office Action under 35 U.S.C. § 112, second paragraph, as being indefinite in connection with the term "predatory lending laws." In support of this rejection, the Office Action states: "Laws are constantly changing and what might be within variance [sic] today may not be within variance [sic] tomorrow... there are lots of example [sic] [in the specification] so

one would not know what one [sic] from what date this claim is referring it [sic]." Applicants respectfully submit that this reasoning is insufficient to support a rejection under 35 U.S.C. § 112, second paragraph.

First, a claim satisfies the requirements of 35 U.S.C. § 112, second paragraph if it: (a) sets forth the subject matter that an applicant regards as his or her invention; and (b) particularly points out and distinctly defines the metes and bounds of the subject matter that will be protected by the patent grant. See 35 U.S.C. § 112, second paragraph; see also M.P.E.P. § 2171. Independent Claim 29 and its associated dependent claims satisfy these requirements. These claims clearly set forth the subject matter which applicant regards as the invention, and they particularly point out the metes and bounds of the subject matter that will be protected by the grant, i.e., a computer-implemented method of detecting predatory lending in connection with one or more loans.

Second, 35 U.S.C. § 112, second paragraph, permits Applicants to broadly claim a genus (i.e., predatory lending laws) which covers the species set forth in the specification of the application (i.e., each example of predatory lending laws provided in the specification of the present application, plus equivalents thereto). Indeed, since the Office Action acknowledges that the specification of the present application is replete with examples of predatory lending laws, Applicant is therefore entitled to present broad claim language which covers each such example, plus equivalents thereto, while still complying with the requirements of 35 U.S.C. § 112, second paragraph. The term

"predatory lending laws" encompasses each example given in the specification, plus equivalents thereto, and is therefore appropriate claim language.

Third, the Office Action contradicts itself in that, on the one hand, it concedes that the specification of the present application discloses predatory lending laws, but on the other hand, rejects claim language which is appropriately directed to the very subject matter disclosed in the specification. Such an outcome is tantamount to denying Applicants claim coverage on the very subject matter that the Office Action acknowledges is disclosed in the specification. Hypothetically, this outcome would be similar to rejecting a claim term "light source" in a patent application which discloses numerous types of light sources in its specification, such as fluorescent lights, light-emitting diodes, halogen lights, etc.

In view of the foregoing, Applicants respectfully submit that "predatory lending laws" is appropriate claim language which is definite in scope and complies with the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, withdrawal of this rejection is respectfully requested.

Applicants respectfully submit that Broadbent, et al. fails to disclose each element of Applicants' claimed invention, as set forth in amended independent Claim 29 and its associated dependent claims.

Independent Claim 29, as amended, recites the steps of “**calculating a total risk score for each loan based on scored variances; assigning a risk category to the loan based on the total risk score; and displaying the total risk score and the risk category** for each loan to a user of the system.” Broadbent, et al. fails entirely to disclose a system which provides both a total risk score and a risk category for a loan, and which displays both the total risk score and the risk category to a user, as set forth in amended independent Claim 29.

The Office Action inappropriately contends that Columns 6 and 7 and lines 10-26 of Column 8 of Broadbent, et al. inherently disclose the aforementioned claimed features of calculating a total risk score for a loan, assigning risk category to the loan based on the total risk score, and displaying the total risk score and the risk category for each loan to a user of the system. MPEP § 2112 requires that any rejection based upon inherency must be supported by evidence that “the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art.” MPEP § 2112, citing *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). Here, no showing has been made that the aforementioned claimed features are **necessarily present** in the referenced excerpts of Broadbent, et al., or anywhere else in Broadbent, et al.

The referenced excerpts merely disclose that Broadbent, et al. provides an automated system which uses Federal, state, local, and professional regulations to

identify a set of tasks required to process a loan application. The language in these excerpts relating to "monitoring and reporting," on which the Office Action places heavy reliance in rejecting the claims (the Office Action specifically focuses on line 23 of Column 8), has absolutely nothing to do with the claimed features of calculating a total risk score, assigning a risk category to a loan, and displaying both the total risk score and the risk category to a user. This is clear from a careful reading of lines 10-26 of Column 8, reproduced below (with annotations):

The present invention provides a solution to the needs described above through a system and method for managing the mortgage loan process. The automated system of the present invention uses the Federal, State, local and professional regulations and requirements and implementing instructions to identify the set of tasks required to process a specific loan application, including tasks required by applicable federal and state law, to use, or provide this set of tasks to a lender to use, to drive the process of handling the specific mortgage loan application, and to monitor and report the completion of the specified tasks as required by these regulations, or alternatively, that the required task completion may be traced to the completing entity.

Clearly, the "monitor and report" functionality disclosed above relates to monitoring and reporting the completion of specific tasks in connection with a loan, and has nothing to do with calculating a total risk score for a loan and assigning a risk category to a loan, much less displaying both a total risk score and a risk category to a user, as required by independent Claim 29.

Moreover, no showing has been provided that the aforementioned claimed features are necessarily present in the referenced excerpts of Broadbent, et al., or anywhere else in Broadbent, et al. Indeed, that Broadbent, et al. discloses monitoring

and reporting the completion of tasks does not mean that Broadbent, et al. necessarily discloses calculating a total risk score for a loan, assigning a risk category to a loan, and displaying this information to a user. Rather, the monitoring and reporting functionality of Broadbent, et al. is directed to an entirely different purpose, i.e., to determine whether required tasks have been performed in connection with a loan. As such, Broadbent, et al. does not inherently disclosed the aforementioned claimed features.

In view of the foregoing, Applicants respectfully submit that amended independent Claim 29 and its associated dependent claims, which include all of the limitations of independent Claim 29, are patentable over Broadbent, et al.

All issues raised in the Office Action are believed to have been addressed. Claims 29-30 and 38-40 were amended, Claim 37 was cancelled, and Claims 29-36 and 38-40 are pending and are in condition for allowance. Re-examination is requested and favorable action solicited.

Respectfully submitted,



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